

**D. AMENDMENTS TO THE DRAWINGS**

Figures 2 and 3 have been amended as requested by the Examiner, and Replacement Figures are enclosed with this Amendment and Response.

Figure 2 has been amended to illustrate the raised surface of the groove as described in the Specification at Paragraph 0027, and as claimed in original claims 13 and 20. Thus, no new matter is added by the amendments to Figure 2.

Figure 3 has been amended to number the rear surface as "36" as described in the Specification at Paragraph 0023. Thus, no new matter is added by the amendment to Figure 3.

### **E. REMARKS**

The present invention is directed to picture frame having a frame member having a front surface and a rear surface separated by a perimeter edge, the frame member adapted to receive and retain a transparent member. The frame member is adapted for removable attachment to a backing member having a display surface and a rear surface separated by a side edge. The rear surface of the backing member comprises mounting means for mounting on a mounting surface. A variety of attachment means, and combinations thereof, are disclosed herein for removably attaching the front member and the backing member, without the need to remove the backing member from a mounting surface.

#### **Status of the Claims**

Claims 1 – 20 are pending in the subject application. This amendment is provided in response to the Office Action dated June 24, 2005.

#### **35 U.S.C. § 112 Rejections**

The Examiner rejected claims 1-15 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner particularly stated: “Regarding claim 1 there is no antecedent basis for ‘the front member’ (line 8).” Applicant submits that the antecedent basis problem is the result of an obvious typographical, wherein Applicant typed “front” instead of “frame” in line 8 of claim 1. This typographical error has been corrected by amending claim 1 herein, and there is no longer an antecedent basis problem. No new matter was added as a result of the amendment. For these reasons, Applicant requests that the Examiner remove the rejection under 35 U.S.C. §112, second paragraph.

**35 U.S.C. 102(b) Rejections**

The Examiner rejected claims 1–3, 7-9 and 16 as being anticipated under 35 U.S.C. § 102(b) by U.S. Patent 5,353,536 to Erber et al.(hereinafter “Erber”). In particular, the Examiner stated:

Erber discloses a picture frame assembly comprised of a frame member 8 having a front surface 8a and a rear surface separated by a perimeter edge 8e, the frame member adapted to receive and retain a transparent member 12; a backing member 6 having a display surface 6a and a rear surface separated by a side edge 6c, the rear surface having mounting means 6d for mounting on a mounting surface; and attachment means 8d for removably attaching the front member and the backing member.

Regarding claim 3, the transparent member disclosed by Erber is plastic (column 7, line 67).

Regarding claims 7 and 8, the attachment means is protruding edge 8d.

Regarding claim 9, the pressure between the frame member and the backing member constitutes artwork retaining means.

Applicants respectfully traverse the rejection of claims 1-3, 7-9 and 16 under 35 U.S.C. §102(b). Erber, as understood, is directed to a display assembly comprised of a compressible sandwich of elements having a rear member that can be mounted to a wall surface, and a cover frame that can be locked to the rear member by a tool which fits through an aperture in the bottom of the cover frame and engages a rotatable fastening device to lock and unlock the cover frame. Significantly, one or more of the features recited by Applicant in amended independent claims 1 and 16 (as well as independent claim 17) are not taught or suggested by Erber, as further described herein.

First, Erber does not motivate, teach, or suggest the claimed attachment means provided on two adjacent sides of the frame member, in combination with spacing means to space the surface of the backing member a predetermined distance from the mounting surface. Erber as cited by the Examiner does not teach any spacing means. Erber teaches the use of a protruding (top) edge in combination with a rotatable locking means provided on an opposite (bottom) portion of the frame cover. As described by Applicant at Paragraph 0024 of the specification, the use of attachment means on adjacent sides allows a sliding assembly to engage the frame member to the backing member, with the spacing means maintaining the edges of the backing member unencumbered so as to permit the frame member to be mounted (and also removed)

without removing the backing member from the mounting surface. Nothing in Erber teaches or suggests this combination.

With respect to the dependent claims 2-3 and 7-9, the additional limitations of claim 1 are not anticipated by Erber, and that underscores the fact that Erber's teachings do not produce a frame assembly having a frame member and backing member that can be slideably and removably attached without removing the backing member from the mounting surface.

Lastly, without conceding any of the above arguments, Applicant has amended claims 1, 16 (and 17) to recite a more particular frame assembly having particular attachment means configurations as well as means for spacing the rear surface of the backing member from the mounting surface. Applicant believes that the amendments to claims 1, 16 (and 17) hereunder make the Examiner's rejection of claims 1-3, 7-9 and 16 under Section 102(b) moot.

Thus, since Erber does not teach or suggest all of the limitations recited in independent claims 1 and 16, Applicant respectfully submits that Erber does not anticipate Applicant's invention as recited in independent claims 1-3, 7-9, and 16.

### **35 U.S.C. 103(a) Rejections**

The Examiner has rejected claims 4-6 and 17 under 35 U.S.C. §103(a) as being unpatentable over Erber in view of U.S. Patent 6,574,896 to Howell ("Howell"). The Examiner stated:

Erber discloses the invention substantially as claimed, as set forth above. However, Erber does not disclose a matting. Howell teaches that it was known in the art to apply a matting image directly to a transparent member in a picture frame. It would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the matting image directly to the transparent member disclosed by Erber, as taught by Howell, in order to achieve a three-dimensional aesthetic effect.

The following principle of law applies to all Section 103 rejections. MPEP 2143.03 provides, "To establish prima facie obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165

USPQ 494, 496 (CCPA 1970).” [Emphasis added.] That is, to have any expectation of rejecting the claims over a single reference or a combination of references, each limitation must be taught somewhere in the applied prior art. If limitations are not found in any of the applied prior art, the rejection cannot stand.

Applicant submits that the amendments to the claims, and particularly to independent claim 1, from which claims 4-6 depend, and to independent claim 17, makes moot the rejection of claims 4-6 and 17 under 35 U.S.C. §103(a) over Erber in view of Howell. Specifically, neither of those references teach or suggest the inclusion of attachment means on two adjacent sides of the frame member, as previously described under the Section 102(b) arguments hereof. Accordingly, the Examiner’s rejection of claims 4-6, which add additional limitations to amended claim 1, is moot. Additionally, with respect to claim 6, Applicant has amended the claim consistent with the Specification at Paragraph 0022 to indicate that the matting is adhered to the transparent member, rather than being “stenciled.” Applicant submits that this is a structural limitation and is therefore appropriate. Applicant requests withdrawal of the rejection under 35 U.S.C. § 103, and consideration and allowance of claims 4-6 and 17.

The Examiner further rejected claims 10-11 under 35 U.S.C. §103(a) as being unpatentable over Erber in view of U.S. Patent 5,419,063 to Lane (“Lane”). The Examiner stated:

Erber discloses the invention substantially as claimed, as set forth above. However, Erber does not disclose an elastic band for retaining the sheet 10. Lane teaches that it was known in the art to retain an odd-shaped object in a frame with an elastic band. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the frame disclosed by Erber with an elastic band, as taught by Lane, in order to retain odd-shaped objects in the frame.

For the above reasons set forth with respect to amended claim 1, Applicant submits that the amendments to claim 1 makes moot the rejection of claims 10-11 under 35 U.S.C. §103(a) over Erber in view of Lane. Accordingly, the Examiner’s rejection of claims 10-11, which add artwork retaining means limitations to claims depending from claim 1, is moot. Applicant

requests withdrawal of the rejection under 35 U.S.C. §103, and consideration and allowance of claims 10-11.

The Examiner further rejected claims 10-12 under 35 U.S.C. §103(a) as being unpatentable over Erber in view of U.S. Patent 5,353,536 to Rousseau ("Rousseau). The Examiner stated:

Erber discloses the invention substantially as claimed, as set forth above. However, the friction that constitutes the artwork retaining means is caused by the interlocking of the frame member with the backing member. Rousseau teaches that it was known in the art to hold frame components together with elastic bands, rather than a mechanical interlock. It would have been obvious to one having ordinary skill in the art at the time the invention was made to hold the frame elements disclosed by Erber together with elastic bands, as taught by Rousseau, in order to facilitate easy separation of the components when desired.

For the above reasons set forth with respect to amended claim 1, Applicant submits that the amendments to claim 1 makes moot the rejection of claims 10-12 under 35 U.S.C. §103(a) over Erber in view of Rousseau. Additionally, the Examiner has misunderstood or misinterpreted Applicant's invention as claimed in claims 10-12. Applicant's claimed artwork retaining means are claimed as a feature of the display surface of the backing member – whereas the elastic bands of Rousseau are elements entirely separate from the frame and backing members. The elastic bands of Rousseau are simply wrapped around the frame and backing to frictionally hold those two elements together as a unitary assembly – they are not a feature of any display surface of the backing member. In the disclosed capacity of Rousseau, the elastic bands of Rousseau are at best similar in function to Applicant's attachment means for removably attaching the frame member to the backing member. There is no absolutely no equivalent in Rousseau to Applicant's artwork retaining means as a feature of the backing member, and certainly not as a feature of the display surface. Accordingly, the Examiner's rejection of claims 10-12, which add readily distinguishable and unprecedented artwork retaining means limitations to claims depending from claim 1, is moot. Applicant requests withdrawal of the rejection under 35 U.S.C. § 103, and consideration and allowance of claims 10-12.

The Examiner further rejected claims 14-15 under 35 U.S.C. §103(a) as being unpatentable over Erber and design selection. The Examiner stated that “Erber discloses the invention substantially as claimed, as set forth above. It would have been obvious to one skilled in the art at the time the invention was made to fabricate the frame member disclosed by Erber from plastic as matter of choice in design, based on such factors as cost and availability of the materials to the designer.”

For the above reasons set forth with respect to amended claim 1, Applicant submits that the amendments to claim 1 makes moot the rejection of claims 14-15 under 35 U.S.C. §103(a) over Erber. Applicant requests withdrawal of the rejection under 35 U.S.C. §103, and consideration and allowance of claims 14-15.

Lastly, the Examiner rejected claims 18-19 under 35 U.S.C. §103(a) as being unpatentable over Erber in view of Howell, and further in view of Rousseau. The Examiner stated:

Erber discloses the invention substantially as claimed, as set forth above. However, the friction that constitutes the artwork retaining means is caused by the interlocking of the frame member with the backing member. Rousseau teaches that it was known in the art to hold frame components together with elastic bands, rather than a mechanical interlock. It would have been obvious to one having ordinary skill in the art at the time the invention was made to hold the frame elements disclosed by Erber together with elastic bands, as taught by Rousseau, in order to facilitate easy separation of the components when desired.

For the reasons set forth with respect to amended claims 1 and 17, and also with respect to the Examiner’s Section 103 rejections of claims 10-12, Applicant submits that the amendments to claim 17 makes moot the rejection of claims 18-19 under 35 U.S.C. §103(a) over Erber. Applicant requests withdrawal of the rejection under 35 U.S.C. §103, and consideration and allowance of claims 18-19.

**Allowable Subject Matter**

The Examiner indicated that claims 13 and 20 would be allowable if rewritten to overcome the rejection under 35 U.S.C. §112, 2<sup>nd</sup> paragraph and to include all the limitations of the base claim and any intervening claims. Claim 20 was also objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. By this amendment, Applicant has amended claim 13 and claim 20 to stand as independent claims correcting language to overcome the 35 U.S.C. §112, 2<sup>nd</sup> paragraph and to incorporate all the limitations of their respective base claims and intervening claims. Therefore, it is submitted that claim 13 and claim 20 are now allowable.

Applicant has amended the claims and added new claims, and submits that no new matter results from the amendments. No new matter is presented by this amendment.

**Amendments to the Drawings**

The Examiner objected to the drawings under 37 C.F.R. 1.83(a), requiring that “the drawings must show every feature of the invention specified in the claims.” The Examiner has requested that “the stenciled matting (claim 6) and the raised surface (claims 13 and 20) must be shown or the feature(s) canceled from the claim(s).”

With respect to the raised surface, Applicant’s original specification fully describes that portion of the groove at Paragraph 0027, and the amendments to Figure 2 are consistent with that description. Applicant has also amended Paragraph 0027 solely to provide the raised portion described therein, and as illustrated in Replacement Figure 2, with an element number, namely “75”. No new matter is entered as a result of the amendments to Figure 2 or the Specification. Applicant respectfully requests the Examiner to withdraw the objection under 37 C.F.R. 1.83(a).

With respect to the stenciled matting, Applicant submits that original Figures 4, 5 and 7 fully illustrate such matting. Indeed, the matting element 42 is shown in all three of those figures as transposed between the transparent member 40 and the display surface



32 of the backing member 30. The illustration of the matting element 42 in those figures would be identical whether the matting 42 is a separate sheet or a stenciled layer of paint. Applicant respectfully submits that the illustration of the matting element 42 in Figures 4, 5 and 7 is sufficient to meet the requirements of 37 C.F.R. 1.83(a), and that the Figures combined with the description in the specification of that element is fully enabling to claim 6 and any other relevant claim(s). Applicant respectfully requests the Examiner to withdraw the objection under 37 C.F.R. 1.83(a).

The Examiner further objected to the drawings under 37 C.F.R. 1.84(p)(5) because “they do not include the following reference sign(s) mentioned in the specification: “36” (para 0023).” As required by the Examiner, Applicant has amended Figure 3 to show the reference sign for element 36, namely the rear surface of the backing member 30. claimed feature of a raised portion of the groove in the display surface of the backing member. Applicant submits that no new matter is presented as a result of the amendments to Figure 3, since the newly numbered feature “36” was already present and was previously described in the original specification. Applicant respectfully requests the Examiner to withdraw the objection under 37 C.F.R. 1.84 (p)(5).

## **F. CONCLUSION**

In view of the above, Applicant respectfully requests entry of this amendment, reconsideration of the Application and withdrawal of the outstanding rejections. As a result of the amendments and remarks presented herein, Applicant respectfully submits that independent claims 1, 16 and 17, as amended, are neither anticipated by the cited prior art nor rendered obvious. Thus, dependent claims 2-15 and 18-20 are not rendered obvious by the cited art.

As the claims are not anticipated by nor rendered obvious in view of the applied art, Applicant requests withdrawal of the outstanding rejections and allowance of claims 1-20. If the Examiner believes that prosecution of this Application could be expedited by a telephone conference, the Examiner is encouraged to contact applicant’s attorney at the phone number listed below.

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The Commissioner is hereby authorized to charge any additional fees and credit any overpayments to Deposit Account No. 50-1059.

Respectfully submitted,

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